

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/058,170 Confirmation No. 7179
Applicant : Terry M. BLEIZEFFER et al.
Filed : April 10, 1998
Title : METHOD AND APPARATUS FOR SETTING PARAMETERS IN A SYSTEM
TC/A.U. : 2173
Examiner : Tadesse HAILU

PRE-APPEAL BRIEF REQUEST FOR REVIEW**MAIL STOP AMENDMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The above-identified application having been finally rejected in the Office Action mailed July 12, 2006, Applicants respectfully submit this Pre-Appeal Brief Request for Review within four months of the mailing date of the Office Action (November 12 having fallen on a Saturday, and a fee for a one-month extension of time being filed concurrently herewith).

Applicants request the review for the reason stated on the attached sheets. No amendments are being filed with this request.

A Notice of Appeal is being submitted concurrently herewith.

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REMARKS/ARGUMENTS

Claims 1, 4-13, 16-25, 28-37, and 40-82 are pending in the application.

In the July 12, 2006 Office Action, claims 1, 11-13, 23-25, 35-37, 47-49, 51, 53, 55, 57, 58, 67-70, and 79-82 were rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 5,675,756 (Benton) in view of USP 6,069,629 (Paterson). Claims 49, 51, 53, 55, 58, and 70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Benton in view of Paterson and further in view of USP 5,535,321 (Massaro).

In light of the Board of Patent Appeals and Interferences decision dated August 25, 2004, affirming the Examiner's prior rejection, Applicants amended the claims to address, in two different ways, a deficiency that the Board identified in Applicants' claims. The relevant language from the Board decision is as follows:

We do not agree with appellants' argument that the phrase "parameters of the program" as used in claim 1 requires the modification of parameters as used by the program for its internal operation or must relate to installing and updating a program within the context of a particular operating system.

(emphasis added)

Applicants discuss the highlighted portions separately, as follows.

- I. **Claims 1, 4-12, 13, 16-24, 25, 28-36, 37, 40-48, and 49-56 are patentable over the prior art of record because the prior art does not teach or suggest the modification of parameters as used by a computer program for its internal operation.**

The first highlighted portion of the Board's decision came up in the context of whether the term "parameters of the program" would exclude data. Applicants had argued that "parameters" did not include data, and that, since the Benton and Paterson references on which

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the Examiner relied, discussed data but not parameters, the claims were patentable. The Examiner and the Board disagreed.

Most of the Examiner's discussion in the present Office Action, which is largely a repeat of the language from the previous Office Action, cites portions of Benton and Paterson that the Examiner had cited to the Board during the appeal (Examiner's Answer, pp. 13-16). Therefore, the Board's attention was focused on these portions in the course of the Board's consideration in reaching its decision.

Applicants understood the Board's reasoning, as set forth above, to mean that "parameters," standing alone in the claims, did not exclude data. Applicants understood further that "parameters" needed to be defined more specifically in the claims in order to distinguish over the teaching of "data" in the applied prior art. Still further, Applicants submit that the Board's decision properly should be interpreted to mean that "parameters as used by the program for its internal operation" does not include data.

Accordingly, Applicants amended independent claims 1, 13, 25, and 37 to recite this language. Assuming for the sake of argument that "data" could be a "parameter" as that term, standing alone in the claims, broadly could have been interpreted, a parameter that the program uses for its internal operation is not data. Applicants submit that this is what the Board held. Applicants submit further that, having amended the claims in the manner that the Board expressly discussed, the Examiner does not have discretion to continue to reject the claims, and in particular, does not have discretion to interpret the Board's language more broadly than the Board itself did.

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On pages 10 and 11 of the current and the previous Office Action, the Examiner cites additional portions of Paterson (col. 17, lines 15-54; col. 18, lines 10-63, and col. 2, lines 32-38) which were not expressly mentioned in the Board's decision, but which were mentioned in the previous Office Action. However, a detailed review of these portions of Paterson likewise yields no relevant teaching or suggestion of parameters used in the internal operation of a computer program, as now recited in independent claims 1, 13, 25, 37, and their dependencies.

Accordingly, pursuant to the foregoing discussion, Applicants submit that claims 1, 4-12, 13, 16-24, 25, 28-36, 37, 40-48, and 49-56 are patentable.

II. Claims 57-82 are patentable over the prior art of record because the prior art does not teach or suggest installing or updating a program within the context of a particular operating system.

The second highlighted portion of the Board's decision came up in the context of whether installing or updating a program occurred within the context of a particular operating system. As the Examiner notes on page 6 of the Office Action, claims 57, 69, 81, and 82 recite, among other things, "wherein said at least one of said loading, installation, migration, fallback, remigration, and update tasks relate to installing or updating the program within a context of an operating system". The Examiner relies on Figs. 3 and 4 of Paterson as allegedly supplying this teaching. However, as with other portions of the prior art, the Examiner referred to Figs. 3 and 4 of Paterson during the appeal (Examiner's Answer, pp. 13 and 14). Thus, the Board had this teaching from Paterson argued directly in front of it. The Board still focused on the language which Applicants highlighted on page 2 of this paper.

The installing or updating of a program within a context of a particular operating system is effectively another approach to defining parameters and differentiating them, to the Board's

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satisfaction, from “data”. In their Appeal Brief, Applicants used this language regarding context of a particular operating system (Brief, pp. 6, 9). To Applicants’ understanding, the Board held that the use of the term “parameters” did not encompass this language, but that this language was not in the claims so as to distinguish “parameters” from “data”. Accordingly, Applicants added independent claims 57, 69, 81, and 82, which were similar to rejected independent claims 1, 13, 25, and 37, but which included this express language.

The Examiner has pointed to no other teaching in Benton or Paterson which teaches or suggests this language, or the resulting definition of “parameter,” either. Therefore, Applicants submit that claims 57-82 are patentable.

CONCLUSION

Based on the above remarks, Applicants believe the claims are in condition for allowance. The Commissioner is authorized to charge any fees or credit any overpayment to the deposit account of Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned to discuss any matter concerning this application.

Respectfully submitted,
KENYON & KENYON LLP

Dated: November 13, 2006

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